

REMARKS

Applicant thanks the Examiner for the proposed claim amendment at page 10 of the Office Action and sincerely appreciates the suggestion to facilitate allowance of the application.

Claims 34 and 39-42 are pending in this application. Claims 7 and 23-25 have been cancelled, without prejudice or disclaimer of that which is defined thereby. Claim 34 has been amended and new claims 39-42 have been added. The amendments to the specification, claim 34 and new claims 39-42 are supported in the specification, such as at paragraphs [0042] through [0045]. No new matter has been added to the application by any of the foregoing amendments.

Restriction Requirement and Provisional Election

A seven-way restriction requirement and an election of species requirement were set forth at pages 2-7 of the Office Action. For brevity, these rejections are not repeated herein but reference is made to the Office Action.

Applicant respectfully traverses the restriction and election of species requirements and requests that the same be reconsidered and withdrawn.

At page 4 of the Office Action, it is alleged that the Inventions (IV or V) and (I, II or III) are related as process of making and product made because the product as claimed can be made by another materially different process such as mixing of the epoxy component and antioxidant and optionally, the phosphor material *without partial cure*. Applicant asserts that there is no undue burden to search the subject matter of each of the Groups (I – VII) due to the components of the composition being similar in the method and composition claims. Therefore, reconsideration and withdrawal of the restriction requirement and election of species requirement is respectfully requested.

To facilitate prosecution of the application and in order to comply with the Examiner's requirements, Applicant hereby provisionally elects with traverse the claims of Group V (claim 34 and new claims 39-42) for initial examination in this application.

For searching purposes only, Applicants provisionally elect:

triglycidyl isocyanurate as the epoxy component;

methyl hexahydrophthalic anhydride as the anhydride; thiodiethylene bis[3-(3,5-di-tert-butyl-4-hydroxyphenyl) propionate as the antioxidant; and yttrium aluminum garnet as the phosphor material.

Elected claims readable thereon include claims 34 and 39-42.

At page 8 of the Office Action, it is alleged that there is no distinction between the structure for the epoxy component depicted in withdrawn claim 6 and the triglycidyl isocyanurate of claim 7 since the structure is triglycidyl isocyanurate and that the word "novolac" is misspelled on page 5, paragraph 23, line 6. While Applicant respectfully disagrees with the allegations, in order to expedite examination claim 7 has been canceled without prejudice and the spelling of "novolac" has been corrected.

Rejection Under 35 USC § 112

At page 8 of the Office Action, claim 34 has been rejected under 35 USC § 112, first paragraph, for an alleged lack of enablement, founded on the assertion that one skilled in the art cannot prepare the molding without the presence of the polyol because the polyol promotes the reaction of the cyclic anhydride component with the epoxy component via ring opening of the anhydride. Further, it is alleged that there is no affirmative inclusion of the anhydride in the epoxy composition which must be present for the mixture to undergo partial curing.

Applicant respectfully traverses the rejection and requests that the rejection be reconsidered and withdrawn.

As discussed at page 8, paragraph 29, lines 1-7 of the specification,

[v]arious agents can be incorporated into the epoxy composition to assist in this ring opening reaction. Such ring opening can be accomplished, for example, by active hydrogens present as water, or by hydroxyls, or by a Lewis base. In one application, a polyol can be incorporated into the epoxy composition to assist in the ring opening of the anhydride and to promote curing of the epoxy composition.

Further, as discussed at page 10, paragraph 36, lines 7-10, more than one glycidyl moiety of the triglycidyl isocyanurate may react with anhydride carboxyls and, in some cases, such reactions may be effected before the anhydride reacts with the polyol. In any event, claim 34 has been

amended to recite that the increase in the viscosity of the homogeneous mixture occurs through initiating reaction of the cyclic anhydride while maintaining the phosphor material suspended within the epoxy composition to thereby form the pre-reacted intermediate. Also, new claim 39 further defines this step of increasing the viscosity through the use of an anhydride ring opening agent, and new claim 40 defines specific conditions including cooling and the use of a polyol. Accordingly, withdrawal of this rejection is respectfully requested.

Also, it is asserted that there is no enablement for the further step in claim 34 of mixing a visible light-emitting phosphor material and conducting another increase in viscosity besides that already done in claim 33. Applicant's amendment to claim 34 obviates this rejection.

Accordingly, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

At page 9 of the Office Action, claim 34 has been rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness for not including the anhydride and polyol to increase the viscosity and partial curing and for alleged lack of clarity regarding an asserted second viscosity increase. While Applicant respectfully traverses and disagrees with this rejection, claim 34 has been amended, thereby obviating this rejection as well. Accordingly, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

At page 11 of the Office Action, a formal rejection under 35 U.S.C. §§ 102 or 103 has not been made. However, statements with respect to the alleged closest prior art are set forth regarding Japanese Patent No. 52-15539 and Shaddock Patent No. 6,518,600 as espousing the mixing of an epoxy resin, luminescent pigment or phosphor, hardener, and partially curing the mixture. It is alleged in the Office Action that the present specification on pages 13-14, Examples 1 and 2 shows the criticality of the claimed method wherein the phosphor is uniformly distributed throughout the composition by increasing the viscosity before partial curing and that Example 1, which is alleged to be representative of the Japanese patent, shows a non-uniform distribution of phosphor by only partial curing. The Office Action contends that the claims must be limited to include the suggested "cooling the homogeneous mixture to a temperature of from about 45°C to about 85°C and adding a polyol" since the viscosity increase only occurs in the presence of the polyol as corroborated by pages 13-14, paragraphs 41 and 42.

Neither JP '539 nor Shaddock disclose or suggest the use of a cyclic anhydride or antioxidant as is presently claimed. Also neither JP '539 nor Shaddock disclose or suggest any initiating reaction of a cyclic anhydride to increase the viscosity of the homogeneous mixture while maintaining the phosphor material suspended within the composition to form the pre-reacted intermediate. Claim 34 has been amended to clarify these features. Accordingly, the pending claims distinguish the presently claimed invention from the cited references.

In view of the remarks above, reconsideration and withdrawal of the rejections, and favorable allowance of all claims is respectfully requested. Should the Examiner have any questions or wish to discuss this matter further, he is invited to contact Applicant's representative at 412-471-8815.

Respectfully submitted,

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